



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,345	03/25/2002	Jan Gerrit Garsen	5034US	8607

7590 01/27/2006
Trask Britt & Rossa
PO Box 2550
Salt Lake City, UT 84110

EXAMINER

SWARTZ, RODNEY P

ART UNIT PAPER NUMBER

1645

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/913,345	Applicant(s) GARSSSEN ET AL.	
	Examiner Rodney P. Swartz, Ph.D.	Art Unit 1645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 11-16, 20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11-13, 15, 16, 20, 21 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8 November 2005 has been entered.

Claims 10, 18, and 19 have been canceled. Claims 1, 13, and 14 have been amended. New claims 20 and 21 have been added.

2. Claims 1-7, 11-16, 20 and 21 are pending and under consideration.

Rejections Moot/Withdrawn

3. The rejection of claim 10 under 35 U.S.C. 112, second paragraph, indefiniteness, is moot in light of the cancelation of the claim.

4. The rejection of claim 19 under 35 U.S.C. 112, second paragraph, indefiniteness, is moot in light of the cancelation of the claim.

5. The rejection of claims 18 and 19 under 35 U.S.C. 103(a) as being unpatentable over Bell et al (*Neuropathology and Applied Neurobiology*, 23(1)26-35, 1997) is moot in light of the cancelation of the claims.

6. The rejection of claim 10 under 35 U.S.C. 102(b) as being anticipated by Grathwohl et al (*Journal of Virological Methods*, 64:205-216, 1997) is moot in light of the cancelation of the claim.

Art Unit: 1645

7. The rejection of claims 18 and 19 under 35 U.S.C. 103(a) as being unpatentable over Grathwohl et al (*Journal of Virological Methods*, 64:205-216, 1997) is moot in light of the cancellation of the claims.

8. The rejection of claims 13 and 14 under 35 U.S.C. 112, second paragraph, indefiniteness, is withdrawn in light of the amendment of the claims.

Rejections Maintained

9. The rejection of claims 1-5, 11-13, and 15 and now new claim 21 under 35 U.S.C. 102(b) as being anticipated by Grathwohl et al (*Journal of Virological Methods*, 64:205-216, 1997) is maintained.

Applicants' argue that the cited reference does not anticipate the instant claims because sample preparation of the instant claims is different from that taught by Grathwohl et al.

Applicants' arguments are not found persuasive because of the open language of the instant claims, i.e., a method "comprising" the listed steps. The use of the open language encompasses not only the listed steps, but may also comprise unlisted steps. In addition, one of the embodiments is preparation by a "functional equivalent" of guanidine thiocyanate. The term, while mentioned in the specification, is not defined. Therefore, the examiner considers "functional equivalent" to include proteinase K. Thus, the methods of Grathwohl et al do read on the instant claims because of the open language of the claims as well as the use of a "functional equivalent".

New claim 21 is included in this rejection because if the claim had been originally submitted with the other claims, claim 21 would have been rejected for the same reasoning.

10. The rejection of claims 6 and 7 under 35 U.S.C. 103(a) as being unpatentable over Grathwohl et al (*Journal of Virological Methods*, 64:205-216, 1997) is maintained.

Art Unit: 1645

Applicants' argue that it would not have been obvious to utilize the methods of Grathwohl et al because sample preparation of the instant claims is different from that taught by Grathwohl et al.

The examiner has considered applicants' argument, but does not find it persuasive for the reasons discussed *supra*, and the reasoning put forth in the original rejection.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 preamble recites obtaining at least one sample from "a" mammal, indicating that the samples do not come from multiple mammals. However, the fourth step recites test "subjects", presumably indicating multiple mammals. Clarification is required to resolve the number of "mammal subjects".

13. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 depends from a rejected claim.

Conclusion

14. No claims are allowed.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney P. Swartz, Ph.D., Art Unit 1645, whose telephone number is (571)


Art Unit: 1645

272-0865. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM EST.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Lynette F. Smith, can be reached on (571)272-0864.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


RODNEY P. SWARTZ, PH.D
PRIMARY EXAMINER
Art Unit 1645

January 23, 2006